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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/008,957 01/20/98 MORIARTY

R

EXAMINER

HM12/1130

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RADIO, R

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

11/30/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/008,957**

Applicant  
**Moriarty et al.**

Examiner  
**Barbara Badio**

Group Art Unit  
**1616**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) 7-9 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-6 and 10-19 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Final Office Action on the Merits of a Continued Prosecution Application**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

2. The rejections of claims 1-6 and 10-19 under 35 USC 103(a) over (1) Holick et al. ('538); (2) Holick et al. ('643); (3) Bishop et al. ('429) and claims 1-4, 10-12 and 15-17 under 35 USC 103(a) over Gulbrandsen et al. ('790) is maintained.

Applicant argues that there is a statistically significant difference between the calcemic activity of the prior art compounds and the claimed compound as shown by the Hedayat declaration filed September 8, 2000 and that the Moriarty declaration is commensurate with the scope of the claims. Applicant's argument was considered but not persuasive for the reasons of record and those given below.

The cited prior art teach that the compounds, including the claimed compounds, act as antiproliferative agents and cell differentiation agents without significantly altering calcium metabolism. Therefore, the ordinary artisan would expect the prior art compounds to not significantly alter calcium metabolism. The ordinary artisan would also expect there to be differences in the degree to which each compound encompassed by the prior art genus alters calcium metabolism. Therefore, it is the

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examiner's position that the results provided in the Moriarty declaration are not unexpected or unobvious and, thus, the Hedayat declaration does not add to the Moriarty declaration.

Applicant also argues that the Moriarty declaration is commensurate with the scope of the claims. The examiner notes that the closest prior art compounds are the corresponding vitamin D<sub>4</sub> compounds. The Moriarty declaration does not compare the compounds of claims 2-6 to their corresponding vitamin D<sub>4</sub> compounds and, thus, the declaration does not commensurate with the scope of the claims.

For these reasons and those given in previous Office Actions, the rejections of claims 1-6 and 10-19 under 35 USC 103(a) over (1) Holick et al. ('538); (2) Holick et al. ('643); (3) Bishop et al. ('429) and claims 1-4, 10-12 and 15-17 under 35 USC 103(a) over Gulbrandsen et al. ('790) is maintained.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone Inquiry Contacts***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Badio whose telephone number is (703) 308-4595. The examiner can normally be reached between 7:30 am and 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, José Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

  
BARBARA P. BADIO, PH.D  
PRIMARY EXAMINER

November 29, 2000